

**REMARKS**

Claims 1 and 2 are pending in this application. The Office Action rejects claims 1-4 under 35 U.S.C. §102(b); and rejects claims 1-5 under 35 U.S.C. §103(a). By this Amendment, claim 1 is amended; and claims 3-5 are cancelled. No new matter is added.

**I. Rejections under 35 U.S.C. §102(b)**

Claims 1-4 are rejected under 35 U.S.C. §102(b) as anticipated by Sakoda, *Synthesis and Crystal Structure of Optically Active 2-[Benzyl(phenyl)amino]ethyl 5-(5,5-Dimethyl-2-oxo-1,3,2-dioxaphosphorinan-2-yl)-1,4-dihydro-2,6-dimethyl-4-(3-nitrophenyl)-3-pyridinecarboxylate(NZ-105)*, Chem. Pharm. Bull. 2377-2381 (1992), p. 40(9). Applicants respectfully traverse the rejection.

Applicants respectfully submit that Sakoda does not disclose the features of amended independent claim 1. Specifically, Sakoda at least fails to disclose that the presently claimed compound is isolated from a *racemate* mixture. See the present specification at, for example, paragraphs [0013] and [0036]-[0040]. Instead, as the Office Action admits at page 2, Sakoda merely discloses a process of purifying the compound of formula 6 therein *when either one of the optically active compounds thereof is present in excess*. See Sakoda at page 9, lines 3-5. Sakoda nowhere discloses purifying the compounds therein from a racemate mixture (i.e. 1:1 mixture of both optical forms of the compound).

Accordingly, independent claim 1 is not anticipated by Sakoda for the reasons discussed above. Dependent claim 2 is therefore also not anticipated for at least the reason that independent claim 1 is not anticipated. Dependent claims 3 and 4 are cancelled.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 1-4 are rejected under 35 U.S.C. §102(b) as anticipated by Matsumoto (JP 02011592). Applicants respectfully traverse the rejection.

Applicants respectfully submit that Matsumoto does not disclose the features of amended independent claim 1. Specifically, Matsumoto at least fails to disclose that the presently claimed compound is isolated from a *racemate* mixture. See the present specification at, for example, paragraphs [0013] and [0036]-[0040]. Instead, as the Office Action admits at page 3, Matsumoto merely discloses a process of purifying the compound of formula I therein *when either one of the optically active compounds thereof is present in excess*. See Matsumoto at page 5. Matsumoto nowhere discloses purifying the compounds therein from a racemate mixture (i.e. 1:1 mixture of both optical forms of the compound).

Accordingly, independent claim 1 is not anticipated by Matsumoto for the reasons discussed above. Dependent claim 2 is therefore also not anticipated for at least the reason that independent claim 1 is not anticipated. Dependent claims 3 and 4 are cancelled.

Additionally, Applicants note that (pursuant to a telephone conference held on November 20, 2008) the Examiner agreed that any next Office Action would be non-final, in view of the fact that Applicants were not provided with a translation of Matsumoto until December 4, 2008. As a result of this delay, Applicants experienced prejudice in the timely preparation of a response to the Office Action, and therefore again thank the Examiner for agreeing to make any next Office Action non-final.

Reconsideration and withdrawal of the rejection are respectfully requested.

## **II     Rejections under 35 U.S.C. §103(a)**

### **A.     Claims 1-4**

Claims 1-4 are rejected under 35 U.S.C. §103(a) as having been obvious over Sakoda in view of Brittain, *Crystallographic Consequences of Molecular Dissymmetry*, Pharmaceutical Research, Vol. 7 (1990), p. 683-690. Claims 1-4 are similarly rejected under 35 U.S.C. §103(a) as having been obvious over Matsumoto in view of Brittain. Applicants respectfully traverse the rejections.

Applicants respectfully submit that the combination of Brittain with either of Sakoda or Matsumoto is improperly based on a hindsight analysis that uses the present disclosure to piece together disparate teachings in the art, in a manner contrary to the understandings of a person of ordinary skill in the art at the time of the present invention.

Specifically, the Office Action admits that neither Sakoda nor Matsumoto teaches or suggests dissolving a racemate of the compound of formula (1) to form a supersaturated solution, and then adding a seed crystal. See the Office Action at pages 5 and 6. However, the Office Action alleges that Brittain addresses this deficiency, because Brittain allegedly teaches "conventional methods of resolution of racemates." Applicants respectfully traverse this allegation, and submit that the techniques disclosed by Brittain are *not* merely conventional methods that are applicable to any compound. Instead, Brittain specifically states that the "Resolution of Conglomerates" method taught at p. 687, right hand column, can be used only "When a particular system has been shown by its phase diagram to be a conglomerate." Page 687, right hand column, third full paragraph. As is discussed in Brittain on page 686, right hand column, "for a racemate compound to exhibit conglomerate behavior, the melting point of the resolved enantiomers must be at least 20°C higher than the melting point of the racemic mixture" and only "about 5-10% of chiral crystalline compounds exist as conglomerates."

Therefore, the methods disclosed by Brittain cannot be used indiscriminately with regard to any chemical compound, but instead can *only be used when specific conditions are met*. The Office Action has made no showing that these conditions were *known to be met with respect to the presently claimed compound of formula (1) in particular*. Therefore, a person having ordinary skill in the art at the time of the present invention would have had no reason or rationale to use the methods disclosed by Brittain with respect to the compound of

formula (1). Thus, the combination of Brittain with either of Sakoda or Matsumoto improperly relies on the present disclosure to piece together unrelated teachings in the art.

Furthermore, Applicants respectfully submit that Brittain's teachings on page 688, discussed by the Office Action on page 5, are not relevant to the presently claimed invention because the presently claimed invention does not use any "derivatization reaction" as is described by Brittain. See Brittain at page 688, "Resolution of True Racemates" section, left hand column.

Accordingly, for at least all of the reasons discussed above, independent claim 1 would not have been obvious over the applied references. Dependent claim 2 therefore also would not have been obvious over the applied references for at least the reason that independent claim 1 would not have been obvious. Dependent claims 3 and 4 are cancelled.

Reconsideration and withdrawal of the rejections are respectfully requested.

**B. Claim 5**

Claim 5 is rejected under 35 U.S.C. §103(a) as having been obvious over Sakoda in view of Brittain, and in further view of Gogassy et al, *Chirality and Selected Organic Chemical Relationships*, HCAPlus 144:22428. Claim 5 is also rejected under 35 U.S.C. §103(a) as having been obvious over Matsumoto. By this Amendment, claim 5 is cancelled. Accordingly, these two rejections are moot.

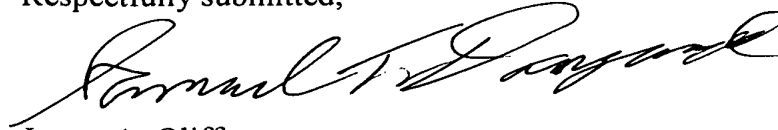
Reconsideration and withdrawal of the rejection are respectfully requested.

**III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Samuel T. Dangremond  
Registration No. 60,466

JAO:STD/std

Attachment:  
Petition for Extension of Time

Date: January 22, 2009

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 320850**  
**Alexandria, Virginia 22320-4850**  
**Telephone: (703) 836-6400**

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